REMARKS

Reconsideration of the application is respectfully requested. Claims 32-33, 36-38, 40-41, 43-45 and 47 remain pending in the application. Applicants appreciate the early indication of allowability as to claims 33 and 41 and the indication of allowable subject matter of claims 38 and 45 in the Official Action.

In the final Official Action, the Examiner rejected claims 32, 36-38, 40, 43-45 and 47 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,872,588 issued February 16, 1999 to Aras et al. ("*Aras*") in view of U.S. Patent No.6,111,872 issued August 29, 2000 to Suematsu et al.("*Suematsu*"). For the reasons set forth below, Applicants traverse these rejections and respectfully request withdrawal thereof.

As set forth in MPEP 2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be

found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present case, these criteria are not met.

As further stated in MPEP 2143.01, "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

The Examiner has cited *Aras* as showing a broadcast-program selection history information acquisition apparatus for acquiring selection history information of broadcast programs. The Examiner has cited *Suematsu* as showing the assignment of transmission timing at random based on an intrinsic random number.

Clearly, motivation to combine these teachings is lacking in the present case. There is no teaching or suggestion in *Aras* that it would be desirable to transmit selection history information stored at a plurality of acquisition times to a notification destination at a timing assigned at random in accordance with an intrinsic random number.

In fact, just the opposite is true. *Aras* teaches that the transmissions should be made either on a periodic basis, when table entries are made, or when the table is nearly full. Thus, *Aras* suggests that the timing of transmissions should be determined based

on the readiness of information to be transmitted and/or the need for periodic reporting. This is clearly contrary to a suggestion that it would be desirable to time transmissions at a randomly assigned timing determined in accordance with an intrinsic random number.

Moreover, it would not be within the knowledge of the person of ordinary skill in the art of home station equipment, e.g. settop device or interactive television (col. 4, ln. 49), to randomly assign a transmission timing because such devices are not known to transmit at randomly assigned timings.

There is also no reasonable expectation of success. Rather, there is an indication that the outcome desired in *Aras* would not have an expectation of success if a randomly assigned transmission timing were used.

As further pointed out in Applicants' last responsive amendment, *Suematsu* indicates a motivation to re-transmit at a randomly assigned timing to avoid further collisions. Indeed, the only suggestion given by *Suematsu* for randomly assigning a transmission timing (being either a first transmission or a re-transmission) is to avoid collisions between transmissions. Col. 2, lns. 56-60.

By contrast, there is no teaching or suggestion in *Aras* that transmissions might collide, or that transmission timing should be assigned in a way to avoid collisions. Rather, as stated above, the problem to be solved through choice of transmission timing is the

presence of information in the table or the fullness of the table at the transmitting end. Without such teaching or suggestion, there is no motivation for a person of ordinary skill in the art to combine the teachings of *Aras* with those of *Suematsu* to form the combination stated by the Examiner.

Applicants have briefly reviewed the remaining prior art references made of record in the Official Action, but not relied upon, and believe them to be no more pertinent to the present invention than as discussed in the present Official Action.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner believes that such action cannot be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By _____
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